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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/389,942 | 09/03/1999 | THOMAS W. MEYER | | 6071 |

7590 11/24/2003
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EXAMINER

INGBERG, TODD D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2124

DATE MAILED: 11/24/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/389,942

Applicant(s)

MEYER ET AL.

Examiner

Todd Ingberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 21-29 and 32-40 is/are rejected.
- 7) ☒ Claim(s) 18, 19, 20, 29, 30 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 1 - 38 have been examined.

Claims 1 - 4, 11, 21, 24, 32, 35 have been amended.

Claims 38 and 39 have been added.

Clarification

1. Instead of holding the response “non-responsive” the Examiner has made several presumptions in the case. These presumptions are found in the drawing section and claim 16 where the claim is dependent on claim 1 in the original filing and the claim number is missing in the amendment but stated to be original. Also, Applicant states that claims 37 and 38 were “previously amended”. this is false they were previously added in a preliminary amendment. Non responsive over such minor items would be detrimental to compact prosecution.

Information Disclosure Statement

2. The resubmitted Information Disclosure Statement (IDS) filed July 14, 2003 has been considered in part. Several references were missing.

Drawings

3. New formal drawings will be required. Examiner did not see a response to the drawings. Examiner will presume the Applicant intends to comply in the near future.

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Specification

Old Business

4. A substitute specification is required the claims is required pursuant to 37 CFR 1.125(a) because the lack of page numbers on the amended Specification.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Corrections Accepted

The amendment to the Specification has been entered. The Examiner "Thanks" Applicant for correcting the following:

5. The Applicant has used URLs in the Specifications- overcome by amendment
6. The use of the trademarks - overcome by amendment

Claim Rejections - 35 U.S.C. § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 15, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. the ability to invent a process of wherein the embedding is effected at substantially greater than a specified speed expressed in terms of bits per second of executable code in the media file. critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The disclosure fails to clearly and concisely provide a means of teaching that will support a claim of any speed. The Examiner give full faith and credit to the enablement of the invention (in other words that it actually runs) but the Disclosure does not provide any evidence to determine what speed the invention can operate at. These limitations should be deleted.

9. Claim 4 is rejected under 112 first paragraph has been overcome by amendment.

10. Claim 11 is rejected under first paragraph has been overcome by amendment.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Prior rejection of claim 3 has been overcome by amendment.

12. Prior rejection of claim 4 has been overcome by amendment.

13. Prior rejection of claim 11 has been overcome by amendment.

14. Prior rejection of claims 21 and 32 have been overcome by amendment.

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Claim Rejections - 35 U.S.C. § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

16. Claims 37 - 38 and 40 are rejected under 35 U.S.C. 102(a,b,e) as being anticipated by **Doyle** as per USPN # 5,838,906 (**Doyle et al**) published November 17, 1998 (filed October 17, 1994).

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Claim 37

Doyle anticipates a process for seamlessly embedding supplementary program content into digital media streams during execution of such streams by digital media content presenting systems (**Doyle**, Abstract and figure on front of patent data objects), that comprises, providing supplementary digital program content in the form of executable code; embedding the executable code into the digital stream (**Doyle**, Abstract, executable); decoding the encoded code during the presenting of the content of the stream by the system; and presenting the supplementary program content of the decoding in response to such decoding during the presenting of the stream content by the system.

(**Doyle**, Abstract, embedded executable for playback in browser and col 11, lines 10 - 16 the MPEG standard by definition).

Claim 38

The process of claim 37 wherein the embedding, decoding and presenting are effected by software control of a computer system; with the presenting effected as playing and/or viewing at a computer screen (**Doyle**, Abstract, after launching user can interact with it - more ability than that is claimed).

Claim 40 - See 35 U.S.C. § 112 First Paragraph Rejection above

The process of claim 37 wherein said embedding is of at least thousands of bits of said supplementary digital program content at data rates from hundreds to thousands of Kilobytes per second. The Doyle Patent is as enabled as Specification for making claims of speed.

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17. Claims 1 - 6, 10,11,13,15,21,22,39,24-25,32-33 and 35are rejected under 35 U.S.C. 102(e) as being anticipated by **Rhoads** et al USPN 6,411,725 with a continuation date of **July 27, 1995**.

NOTE:

- Claim the claims state media file - specific types of data such as audio, video, 3-D and advertisements are considered data type and carry no patentable weight.
- Claim limitations such as MP3 and other formats are standard formats for data and carry no patentable weight.

Claim 1

Rhoads anticipates a process for supplementing pre-prepared media digital file content to be performed by a digital playback apparatus with supplemental digital program content constituting a supplemental media file, that comprises, preparing such supplemental digital program content in the form of executable code representing said supplemental media file; and embedding the executable code representing said supplemental media file into the preprepared media file for execution by the playback apparatus supplementary to the playback of the pre-prepared media file content.

Examiner's Remarks

Rhoads in the Abstract has both a video file and auxiliary information which is embedded.

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The actions to link are performed during playback as per the Abstract. Figure 1A shows the overview of the process.

Claim 2

The process of claim 1 wherein the media file has not been pre-prepared to contain such executable code, and the code is seamlessly embedded in the media file as supplemental digital program sequences of executable code representing said supplemental media file.

Examiner's Remarks

As per the rejection of claim 1 and #114 of Figure 1A.

Claim 3

The process of claim 2 wherein the media digital file program content has been pre-prepared from the group consisting of audio, video, image, 3-D, database information and combinations.

Examiner's Remarks

Video as per claim 1.

Claim 4

The process of claim 3 wherein the sequences of executable code are prepared in a computer program format.

Examiner's Remarks

Abstract the video sequence and embedding is executable as per #114 of Figure 1A.

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Claim 5

The process of claim 4 wherein the sequences of executable code are prepared from the group consisting of computer-programmed Java class files, Macromedia Shockwave, Flash, binary executables, byte codes, Visual Basic and Java Script.

Examiner's Remarks

Abstract the video sequence and embedding is executable (binary executable) as per #114 of Figure 1A.

Claim 6

The process of claim 4 wherein the program content of said sequences of executable code are selected as one or more of graphic, interactive, and e-commerce content.

Examiner's Remarks

Video objects are graphic as per claim 1.

Claim 8

The process of claim 3 wherein the media file has been pre prepared to comprise audio program format and the embedded executable code is prepared to provide image supplementation.

Examiner's Remarks

As per claim 1

Claim 9

The process of claim 1 wherein the embedding in the media file is effected at predetermined time intervals.

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Examiner's Remarks

The linking would require a predetermined interval to enable the seamless aspect.

Claim 10

The process of claim 1 wherein the execution of the code is synchronized with the playback of the media files.

Examiner's Remarks

As per claim 1.

Claim 11

The process of claim 1 wherein said embedding of the executable code into the media file is effected seamlessly.

Examiner's Remarks

Seamlessly is a broad term the reference is interpreted as being able to provide the link seamlessly.

Claim 13

The process of claim 1 wherein the embedding is effected by steganographic techniques.

Examiner's Remarks

Abstract - steganographic techniques are employed.

Claim 15 - See 35 U.S.C. § 112 First Paragraph Rejection above

The process of claim 13 wherein the embedding is effected at substantially greater than 300 bits/second of executable code in the media file.

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Claim 21

The process of claim 13 wherein the executable code is transformed into a bit stream and inserted and embedded at selected locations in the media file identified as locations

Examiner's Remarks

Phoads, Col 6, lines 1 -35.

Claim 22

The process of claim 1 wherein prior to the encoding embedding of the executable code into the media file, the media file is subjected to a digital watermarking process.

Examiner's Remarks

Abstract -watermarking is employed.

Claim 24

A system for flexibly adding supplemental digital program content representing a supplemental media file to the playback of a pre prepared media digital file by digital playback apparatus, comprising, means for modifying the pre-prepared media file to embed sequences of executable code therein representing such supplemental program content media file; means provided in the digital playback apparatus for decoding the embedded code representing said supplemental media file during playback of the modified media file at the digital playback apparatus; and, in addition to means for playing back the pre-prepared a content of the media file, means provided at the

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digital playback apparatus responsive to the decoding for also presenting thereat the supplemental program content embedded media file.

Examiner's Remarks

As per claim 1.

Claim 25

The system of claim 24 wherein the executable code sequences are selected to contain one or more of graphic, interactive and e-commerce program content.

Examiner's Remarks

Graphics as per claim 1

Claim 32

The system of claim 24 wherein the modifying means comprises steganographic coding means and wherein means is provided for transforming the executable code into a bit stream and for inserting and embedding bits at selected locations in the media file, identified as locations

Examiner's Remarks

Rhoads, col 6, lines 1 - 35.

Claim 33

The system of claim 24 wherein means is provided, operable prior to the encoding-embedding of the executable code into the media file, for subjecting the media file to a digital watermarking process.

Examiner's Remarks

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As per claim 22.

Claim 35

A method of conducting advertising and e-commerce business through an expanded use of digital media playing apparatus, that comprises, seamlessly embedding in digital entertainment media files preprepared for entertainment playback by said apparatus, executable code representing supplementary digital advertising and e-commerce business solicitation program content media file; and modifying said apparatus to enable also decoding of said code by the apparatus so as to enable playback at said apparatus of said business solicitation program content media file as a supplement to the playback of the entertainment file thereby to provide business solicitation opportunities not previously provided at such apparatus.

Examiner's Remarks

As per claim 1.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims N , N and N are rejected under 35 U.S.C. 103(a) as being unpatentable over

Rhoads as per above in view of .

Claim 7

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The process of claim 6 wherein said program content includes one or more of advertising, transactional advertising, interactive music videos, and e-commerce.

Examiner's Remarks

Rhoads does not explicitly teach the linking of ads in the data link. It is Ebisawa who teaches linking advertisements (**Ebisawa**, Col 1, lines 30 - 55) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to link advertisements as data because Advertisements generate revenue.

Claim 12

The process of claim 11 wherein a checksum is used during the execution of the code at the playback, to verify that the embedded executable code has been extracted correctly.

Examiner's Remarks

Official Notice is taken that checksums are well known in the art and would have been obvious to one of ordinary skill at the time of invention because the use of checksums provides for data integrity.

Claim 14

The process of claim 13 wherein the encoding of the executable code in the media file is effected by one of low-bit encoding and frequency domain low-bit encoding.

Examiner's Remarks

Official Notice is taken that low-bit encoding and frequency domain low-bit encoding are well known in the art and would have been obvious to one of ordinary skill at the time of invention

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because the use of low-bit encoding and frequency domain low-bit encoding provides for data encoding.

Claim 16

The process of claim 1 wherein the media file is an MPEG audio file containing and MP3 audio stream.

Examiner's Remarks

Official Notice is taken that providing a conversion from MPEG to MP3 is common and would have been known to one of ordinary skill in the art at the time of invention, because video display of different types improves flexibility.

Claim 17

The process of claim 16 wherein, in the encoding process, the executable code is unsynchronized from synchronization bytes of the audio stream and encapsulated in ID3v2 format before insertion at the beginning of the MP3 audio stream from the audio file.

Examiner's Remarks

The limitations of claim 17 are inherent to perform the limitations of claim 16.

Claim 23

The process of claim 1 wherein the pre-prepared media file is an MP3 file and the executable code is seamlessly embedded therein and prepared to provide the supplemental program content selected from the group consisting of transactional advertising, games, polls, contests, interactive music videos and e-commerce.

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Examiner's Remarks

Rhoads does not limit itself to a current standard such MP3 when video objects and embedding are taught (**Rhoads**, Abstract) . However, it is **Ebisawa** who teaches games. Therefore, it would be obvious to one of ordinary skill in the art at the time of invention because adding advertisement to video data provides the means for advertising.

Claim 26

The system of claim 25 wherein said program content includes one or more of advertising, games, polls, contests, interactive music videos and e-commerce.

Examiner's Remarks

As per claim 25

Claim 27

The system of claim 24 wherein the media file is an MPEG audio file containing an MP3 audio stream.

Examiner's Remarks

Rhoads does not limit itself to one format. Rhoads teaches video objects. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use current formats for video such as the MPEG and MP3 format, because they were current..

Claim 28

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The system of claim 27 wherein the modifying means comprises means for unsynchronizing the executable code from synchronization bytes of said audio stream and encapsulating the code in ID3v2 format before insertion at the beginning of the MP3 audio stream from the audio file.

Examiner's Remarks

As per claim 17.

Claim 34

The system of claim 24 wherein the pre-prepared media file is an MP3 file and the executable code is seamlessly embedded therein and prepared to provide supplemental program content selected from the group consisting of transactional advertising, games, polls, contests, interactive music videos and e-commerce.

Examiner's Remarks

As per claim 23.

Claim 36

The method of claim 35 wherein the media file contains audio MPEG formats and said playback apparatus is adapted for playing MP3 data streams of such formats.

Examiner's Remarks

As per claim 27.

Claim 39 - See 35 U.S.C. § 112 First Paragraph Rejection above

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The process of claim 1 or claim 2 wherein said embedding is of at least thousands of bits of said supplemental digital program content data at data rates from hundreds to thousands of Kilobytes per second.

Allowable Subject Matter

20. Claims 18, 19, 20, 29, 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Please, note claims like 39 will not be allowed despite rolling the allowable subject matter. The 112 first rejections are not enabled.

Claims 19, 29 and 30

The system of claim 29 wherein the MPEG audio file is recompressed to ensure room for executable code at the end of the frames.

Examiner's Remarks

Prior art search did not reveal this technique. Examiner is giving full faith and credit to the Oath and Declaration of first to invent.

Claims 20 and 31

The system of claim 27 wherein means is provided for encoding the executable code in private data packets for the insertion and embedding of new private data packets into the existing MPEG file.

Examiner's Remarks

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Prior art search did not reveal this technique. Examiner is giving full faith and credit to the Oath and Declaration of first to invent.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence Information

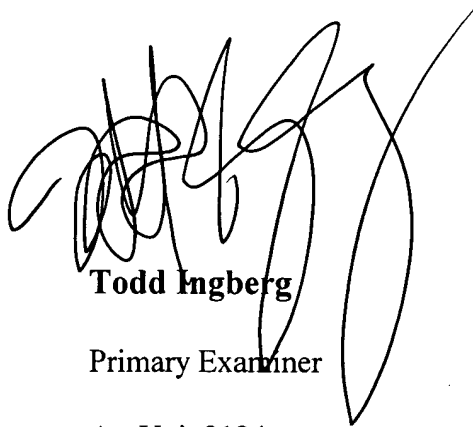
22. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Todd Ingberg** whose telephone number is **(703) 305-9775**. The Examiner is working a Maxi-Flex schedule and can be reached Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the **Examiner's Supervisor, Kakali Chaki** be reached at **(703)305-9662**. Any response to this office action should be mailed

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to: **Director of Patents and Trademarks Washington, D.C. 20231**, or **Hand-delivered** responses should be brought to **Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist located on the fourth floor)**, or **faxed**. The following **fax numbers** apply:

Official

(703) 872-9306

A large, stylized handwritten signature in black ink, appearing to read 'Todd Ingberg', is written over the printed name and title.

Todd Ingberg

Primary Examiner

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November 16, 2003